

REMARKS

Claims 1-11 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness

The Office Action rejects claims 2, 3, 5, 9, and 10 under 35 U.S.C. § 103 as being unpatentable over Hunt et al. (US Patent No. 5,764,235) in view of Katsurabayashi et al. (US Patent No. 5,996,002). This rejection is respectfully traversed.

With respect to claims 2 and 3, the Office Action states:

As per claims 2 and 3, Hunt discloses:

- Generating an image file in response to specifying image data by an operator of said client terminal (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-51);
- Converting said image file to generate a predetermined formed compressed image data which has a file name relating to said unique image file name (column 1, lines 48-51, column 8, lines 50-52, column 9, lines 6-15);
- Displaying said predetermined formed compressed image data of said server on a Web browser on said client terminal (column 3, lines 10-12, 49-52, column 5, lines 43-55, column 10, lines 44-49, column 11, lines 11-13, column 12, lines 20-23).

Whenever a server stores, retrieves, or sends a file to a client terminal as a result of a request, the server gives a unique file name to the file in order to distinguish the requested file from other files that are stored on, retrieved, or sent from the server and allowing a record of the transmission to be stored in the server's log or database (column 2, lines 34-43, 47-48, 50-52, column 4, line 66, column 5, lines 1-6, 23-29, column 8, lines 41-44, column 11, lines 5-9). Therefore, determining a unique image file name from the server is implicit in Hunt's disclosure.

Hunt does not explicitly disclose:

- Sending said predetermined formed compressed image data to said server.

However, the use and advantages for sending the image data to the server is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Kat. Kat discloses data created by an operator of a client computer sending the data to an "individual data sender" (server) for sending the individual data to other computers (abstract, column 4, lines 4-19).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate sending image data to the server in Hunt's method in order for the changed data to be passed from the operator of the client computer to other computers in response to a command from the specific operator who created the individual or changed data.

Office Action, dated January 15, 2003. Applicant respectfully disagrees. Katsurabayashi does not teach or suggest "sending said predetermined formed compressed image data to said server," as recited in claims 2 and 3. The Office Action alleges that an "individual data sender" in Katsurabayashi is a server. Katsurabayashi teaches a plurality of personal computers for a plurality of participants. See Katsurabayashi, **Figure 2**, col. 5, line 65, to col. 6, line 64. However, Katsurabayashi does not teach or suggest that image data is sent from a client to a server. In fact, the word "server" does not appear anywhere in Katsurabayashi.

Simply stated, a personal computer is not necessarily equivalent to a server. Katsurabayashi does not teach or suggest the subject matter alleged in the Office Action. Neither Hunt nor Katsurabayashi teaches or suggests "sending said predetermined formed compressed image data to said server," as recited in claims 2 and 3. The applied references, taken alone or in combination, fail to teach or suggest the claimed invention; therefore claims 2 and 3 are not rendered obvious by the proposed combination of Hunt and Katsurabayashi. Claims 5, 9, and 10 recite subject matter addressed above with respect to claims 2 and 3 and are allowable for the same reasons.

Furthermore, Katsurabayashi actually teaches away from the presently claimed invention since Katsurabayashi directs one to client-to-client communication rather than a client/server environment, as in the claimed invention. See *In re Hedges*, 228 U.S.P.Q. 685 (Fed. Cir. 1986). Thus, one of ordinary skill in the art would not be motivated to make the combination proposed by the Office Action.

Moreover, the Office Action may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of Applicant's disclosure. *Id.* The proposed motivation of "in order for the changed data to be passed

from the operator of the client computer to other computers in response to a command from the specific operator who created the individual or changed data" is not supported by the applied prior art, because Katsurabayashi does not teach or suggest a server. Therefore, absent some teaching, suggestion, or incentive in the prior art, Hunt and Katsurabayashi cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicant's disclosure a model for the needed changes.

Therefore, the rejection of claims 2, 3, 5, 9, and 10 under 35 U.S.C. § 103 is overcome.

The Office Action rejects claims 1, 7, and 8 under 35 U.S.C. § 103 as being unpatentable over Hunt in view of Peterson et al. (US Patent No. 6,502,137). This rejection is respectfully traversed.

With respect to claim 1, the Office Action states:

As per claim 1, Hunt, discloses a method of communication on a communication system having a client terminal connecting to a server through a network and implicitly collaborating with other client terminals connected to said network, said method comprising the steps of:

- Generating an image file in response to specifying an image area by an operator of said client terminal (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-51);
- Converting said image file to generate a predetermined formed compressed data which has a file name relating to said image file name (column 1, lines 48-51, column 8, lines 50-52, column 9, lines 6-15);
- Displaying said predetermined formed compressed data of said server on a Web browser on said client terminal (column 3, lines 10-12, 49-52, column 5, lines 43-55, column 10, lines 44-49, column 11, lines 11-13, column 12, lines 20-23).

Hunt further discloses receiving a file name from the server.

Whenever a server stores, retrieves, or sends a file to a client terminal as a result of a request, the server gives a unique file name to the file in order to distinguish the requested from other files that are stored on, retrieved, or sent from the server allowing a record of the transmission to be stored in the server's log or database (column 2, lines 34-43, 47-48, 50-52, column 4, line 66, column 5, lines 1-6, 23-29, column 8, lines 41-44, column 11,

lines 5-9). Therefore, Hunt teaches acquiring an image file name from the server.

Hunt also discloses an image processing that image files undergo at the server to customize the images before being sent to the client. This process modifies the image file using compression (column 5, lines 18-33, column 8, lines 31-52). Therefore, Hunt implicitly discloses sending said predetermined formed compressed image data to said server.

Hunt fails to explicitly disclose:

- Posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal.

However, the use and advantages for implementing this step is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Peterson (column 3, lines 55-61).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal in Hunt's method in order for the receiving clients to know what the data is although it may have been translated.

Office Action, dated January 15, 2003. Applicant respectfully disagrees. As stated earlier in the Office Action, Hunt does not teach or suggest "sending said predetermined formed compressed image data to said server," as recited in claim 1.

Yet, the Office Action now states that, since Hunt teaches image customization, Hunt also "implicitly discloses sending said predetermined formed compressed image data to said server." Clearly, image customization is not equivalent to sending predetermined formed compressed image data to a server. It is unclear why Hunt fails to teach this feature with respect to claims 2, 3, 5, 9, and 10, yet Hunt somehow **implicitly** discloses the feature with respect to claim 1. The Office Action does not show that Hunt teaches "sending said predetermined formed compressed image data to said server," implicitly or otherwise.

Peterson also fails to make up for the deficiencies of Hunt. In fact, Peterson also fails to teach or suggest, "posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal," as recited in claim 1. Peterson is concerned with security when accessing files from a server by a client. Peterson, however, is not concerned with collaborating client terminals. The cited portion of Peterson states:

When an HTTP server 102 receives an input message from a client browser 126, it contains a URL (Uniform Resource Locator) on the first line of the message. This is effectively a string of data that informs the HTTP server 102 what the request is for. The URL may translate to an HTML file name, which the HTTP server 102 will read and send back to the client 101.

Peterson, col. 3, lines 55-61. Neither this cited passage nor any other portion of Peterson teaches or suggest, "posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal," as alleged in the Office Action. The applied references, taken alone or in combination, fail to teach or suggest the presently claimed invention. Therefore, claim 1 is not rendered obvious by a combination of Hunt and Peterson. Claims 7 and 8 recite subject matter addressed above with respect to claim 1 and are allowable for the same reasons.

Moreover, the Office Action may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of Applicant's disclosure. *Id.* The proposed motivation of "in order for the receiving clients to know what the data is although it may have been translated" is not supported by the applied prior art, because neither Hunt nor Peterson teach or suggest collaborating client terminals. Therefore, absent some teaching, suggestion, or incentive in the prior art, Hunt and Peterson cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicant's disclosure a model for the needed changes.

Therefore, the rejection of claims 1, 7, and 8 under 35 U.S.C. § 103 is overcome.

The Office Action rejects claims 4, 6, and 11 under 35 U.S.C. § 103 as being unpatentable over Hunt in view of Blumer et al. (US Patent No. 5,732,219). This rejection is respectfully traversed.

With respect to claim 4, the Office Action states:

As per claim 4, Hunt discloses a method of communicating on a communication system comprising:

- A client terminal connecting with a network and a server connecting with said network (column 4, lines 63-66, column 5, lines 34-39);
- Storing a file created by an operator of said client terminal which has a name capable of determining that it was created by said operator (column 4, line 66, column 5, lines 1-2, 23-29, column 8, lines 41-44, column 11, lines 5-9);
- Receiving a message sent from the client terminal including information capable of identifying said operator (column 2, lines 34-40, column 3, lines 2-4, 18-19, column 5, lines 26-28, column 11, lines 7-9);
- Acquiring the information capable of identifying said operator included in said message (column 2, lines 37-39, column 3, lines 15-16, column 5, lines 23-29, column 11, lines 7-9);

Whenever a server stores, retrieves, or sends a file to a client terminal as a result of a request, the server gives a unique file name to the file in order to distinguish the requested file from other files that are stored on, retrieved, or sent from the server and allowing a record of the transmission to be stored in the server's log or database (column 2, lines 34-43, 47-48, 50-52, column 4, line 66, column 5, lines 1-6, 23-29, column 8, lines 41-44, column 11, lines 5-9). Therefore, the use of acquiring a file name of the file created by operator on said information capable of identifying said operator is implicit in Hunt's disclosure.

Hunt further discloses, sending the image file to the client terminal to be displayed with the web page (column 10, lines 37-49). Whenever a file is sent to a client terminal, the file name, which is acquired from the server, is sent with the file. Therefore, posting the file name of said image data to the client terminal is inherent in Hunt's disclosure.

Hunt does not explicitly disclose:

- Generating a file list file by inserting said file name into a skeleton file.

However, the use and advantages of generating a file list file is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Blumer (column 3, lines 17-24, column 4, lines 36-40).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate generating a file list in Hunt's method in order to access documents stored on the server.

Office Action, dated January 15, 2003. Applicant respectfully disagrees. Hunt explicitly teaches a browser client requesting an image by URL, as discussed above. There is no teaching, implicit or otherwise, that such an image is created by the operator making the

request. Once again, the Office Action attempts to fill in the holes of the reference by supposed implicit or inherent teachings, even though the actual teachings of the reference are to the contrary.

Hunt also fails to teach or suggest "posting the file name of said file list file to said client terminal." The Office Action admits that Hunt does not disclose generating a file list file, yet the Office Action alleges that Hunt inherently teaches posting the file name of the file list file to the client terminal. Hunt cannot possibly teach posting a file name for a file list file if Hunt does not teach generating the file list file. The remainder of the rejection is based on this faulty premise and, thus, the rejection is fatally flawed.

Furthermore, Blumer fails to teach or suggest, "generating a file list file by inserting said file name into a skeleton file," as alleged in the Office Action. The cited portion of Blumer states:

Each document object in the WWW has an identifier called a Uniform Resource Identifier (URI). These identifiers are described in more detail in *Uniform Resource Identifiers for the World Wide Web*, T. Berners-Lee, submitted as an Internet Request for Comments (RFC) as yet unnumbered. A URI allows any object on the Internet to be referred to by name or address, such as in a link in an HTML document as shown above.

Blumer, col. 3, lines 17-24.

The Web server program also typically maps document object names that are known to the client to file names on the server file system. This mapping may be arbitrarily complex, and any author or program that tried to access documents on the Web server directly would need to understand this name mapping.

Blumer, col. 4, lines 36-41. Neither the cited portions nor any other portions of Blumer teach or suggest "acquiring the file name of the file created by said operator based on said information capable of identifying said operator," "generating a file list file by inserting said file name into a skeleton file," and "posting the file name of said file list file to said client terminal," as recited in claim 4. Simply mapping file names and identifying files by a URI is not equivalent to generating a file list file, inserting a file name into a skeleton file, or posting a file name to a client terminal. In fact, Blumer teaches that files

are explicitly requested by the client terminal and mapping requested file names to files on the server. Therefore, Blumer teaches away from the claimed features of "generating a file list file by inserting said file name into a skeleton file" and "posting the file name of said file list file to said client terminal." See *In re Hedges*, 228 U.S.P.Q. 685 (Fed. Cir. 1986). Thus, one of ordinary skill in the art would not be motivated to make the combination proposed by the Office Action.

The applied references, taken alone or in combination, fail to teach or suggest the presently claimed invention. Therefore, claim 4 is not rendered obvious by the proposed combination of Hunt and Blumer. Claims 6 and 11 recite subject matter addressed above with respect to claim 4 and are allowable for the same reasons.

Moreover, the Office Action may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of Applicant's disclosure. *Id.* The proposed motivation of "in order to access the documents on the server" is not supported by the applied prior art, because this objective can be achieved without a combination of Hunt and Blumer. Therefore, absent some teaching, suggestion, or incentive in the prior art, Hunt and Blumer cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicant's disclosure a model for the needed changes.

Therefore, the rejection of claims 4, 6, and 11 under 35 U.S.C. § 103 is overcome.

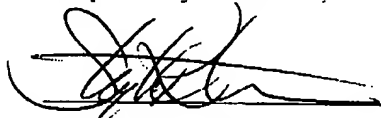
II. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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